

1642 IFW



Attorney Docket No.: 2543-1-039PCT/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Jonathan Alexander Terrett
SERIAL NO. : 10/510,507 EXAMINER : Aeder, Seane E
FILED : April 20, 2005 ART UNIT : 1642
FOR : DIAGNOSIS OF CARCINOMA USING RAIG1
POLYPEPTIDES

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on June 6, 2006.

Lois A. Snure
(Name of Depositor)

Lois A. Snure 6/6/06
(Signature and Date)

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop: AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Restriction Requirement mailed from the U.S. Patent and Trademark Office on May 10, 2006 having a due date for response of June 10, 2006. It is believed that no fees are due in connection with this submission, however, if any fees are due, please charge our Deposit Account No. 11-1153.

Regarding Restriction Requirement

The Examiner requires selecting one group of claims for examination. The groups are as follows:

Group I, claims 1-5, 7 and 20, directed to screening or diagnosing by detecting a polypeptide;

Group II, claims 1, 2, and 20, directed to screening or diagnosing by detecting a polynucleotide;

Group III, claims 1-5, 7 and 20, directed to monitoring effectiveness of therapy by detecting a polypeptide;

Group IV, claims 1, 2, and 20, directed to monitoring effectiveness of therapy by detecting a polynucleotide;

Group V, claims 6 and 8, drawn to an antibody;

Group VI, claim 9, drawn to a diagnostic kit;

Group VII, claims 10 and 12, directed to treating with a polypeptide;

Group VIII, claims 10 and 12, directed to treating with an antibody;

Group IX, claim 11, directed to treating with an antibody;

Group X, claims 13, 14-17 and 18, directed to a method for screening for agents that interact with or modulate activity of a polypeptide;

Group XI, claims 15-17, directed to method for screening for agents that modulate expression of a polypeptide;

Group XII, claims 15-17, directed to method for screening for agents that modulate expression of a polypeptide;

Group XIII, claim 19, directed to treating cancer with an agent that interacts with or modulates a polypeptide;

Group XIV, claim 19, directed to treating cancer with an agent that alters polypeptide expression; and

Group XV, claim 19, directed to treating cancer with an agent that alters polynucleotide expression.

Applicants herein elect Group IX, claim 11, directed to treating with an antibody with traverse. Applicants respectfully request reconsideration of the Requirement for Restriction to allow prosecution of more than one group of claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions with properties so distinct as to warrant separate Examination and Search. The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, is in order.

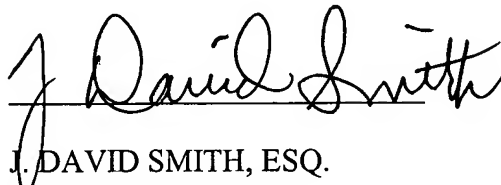
Regarding Election of Species Requirement

The Examiner also issues a requirement that Applicants initially elect one particular cancer selected from breast, pancreatic, lung, liver, ovarian, colon and osteosarcoma for examination. Applicants herein elect colon cancer. However, Applicants respectfully remind the Examiner of the obligation to examine the different carcinomas one at a time until one is found not to be patentable.

CONCLUSION

It is believed that all of the claims are patentable and early notification as such is earnestly solicited. If any issues may be resolved by way of telephone, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. David Smith", written over a horizontal line.

J. DAVID SMITH, ESQ.
Attorney for Applicant
Registration No. 39,839

KLAUBER & JACKSON LLC
411 Hackensack Avenue, 4th Floor
Hackensack, NJ 07601
(201) 487-5800